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EXAMINER

HAMDAN, WASSEEM H

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/028,333	Applicant(s) WIERSMA, JELLE	
	Examiner Wasseem H Hamdan	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Part III - DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 17, 19, 21 and 23, are rejected under 35 U.S.C. 102(b) as being anticipated by Axelrod et al. (US Patent 4,800,505).

Regarding claims 1, 21 and 23, Axelrod et al. discloses a system for generating printed mail pieces [FIG. 1; column 1, lines 6-10], starting from a print file [FIG. 1], comprising:

a printer [FIG. 1 (90; 20)] for printing postal items [column 2, lines 27-44];

a processing device [FIG. 1 (10); column 4, lines 5-10] for processing printed postal items [column 2, lines 27-44] into mail pieces, the processing device comprising at least one mechanical device [86] for mechanically action upon said printed postal items;

a control unit [column 1, lines 42-45; FIG. 1 (10 and 62); column 2, lines 59-65] for controlling unit the printer [FIG. 1 (90; 20)] and the processing device [FIG. 1 (10); column 4, lines 5-10], comprising

an input interface [FIG. 1 (40)] for inputting a rough print file [FIG. 1 (70)] for controlling the printer [FIG. 1 (90)], wherein the rough print file at least partly defines at least one document to be printed [FIG. 1 (70)],

a processor [FIG. 1 (62)]for processing the rough print file [FIG. 1 (70)] in accordance with processing instructions into a processed print file, the processed print file

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comprising instructions for controlling the printer and the processing device [FIG. 1; 2; column 3, lines 66-68; column 1-5]

an output interface [FIG. 1 (40)] connected with said printer [FIG. 1 (20)] and with said processing device [FIG. 1 (10); column 4, lines 5-10] for transmitting control signals to at least said printer or said processing device [FIG. 1 (10); column 4, lines 5-10] for controlling said printer and said processing device in accordance with, or formed by, said processed print file,

and memory [FIG. 1 (64); column 2, lines 50-52].

processing code for controlling said control unit for processing said rough print file into the processed print file, which processing code comprises processing instructions [column 3, lines 35-37; column 6, lines 3-4; column 8, lines 39-44 and 48-53], and

representation code for causing said processing instructions to be represented in humanly interpretable form, said representation code being editable by an operator of said system for changing at least said representations of said processing instructions, and said representation code being convertible into an accordingly changed version of said processing code [FIG. 3; column 3, lines 58-60; column 4, lines 30-42].

Even though the functional language that is recited in the claims is not word for word taught by the reference, Axelrod et al. discloses a system that is capable of performing the same exact functions. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP 2114. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference

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relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (anticipation rejection affirmed based on Board's factual finding that the reference dispenser (a spout disclosed as useful for purposes such as dispensing oil from an oil can) would be capable of dispensing popcorn in the manner set forth in appellant's claim 1 (a dispensing top for dispensing popcorn in a specified manner)) and cases cited therein. See also MPEP § 2112 - § 2112.02.

Regarding claims 1, 17 and 23, Axelrod et al. discloses processing code for controlling said control unit for processing said rough print file into the processed print file, which processing code comprises processing instructions [FIG. 1; FIG. 2; FIG. 3; column 4, lines 53-55 (even though, Axelrod does not specifically disclose the instruction, it is inherent for the system of FIG. 1 and the flow charts of FIGS 2 and 3, to have set of instructions)]; and

representation code for causing said processing instructions to be represented in humanly interpretable form [FIG. 1; FIG. 2; FIG. 3; column 6, lines 37-68, even though, Axelrod does not specifically disclose the "instructions", it is inherent for the system of FIG. 1, and the flow charts of FIGS 2 and 3, to have set of instructions], said representation code being editable [column 3,

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lines 12-21] for changing at least said representations of said processing instructions, and said representation code being convertible into said processing code [FIG. 1; FIG. 2; FIG. 3; column 4, lines 53-55].

Regarding claim 2, Axelrod et al. discloses wherein said representation code is arranged for editable representing at least variables [column 3, lines 5-21] of said processing instructions.

Regarding claim 3, Axelrod et al. discloses wherein said representation code is arranged for editably representing at least formal parameters [column 3, lines 5-21] of said processing instructions [please see claim 1 for the "instructions"].

Regarding claim 4, Axelrod et al. discloses a display [FIG. 1 (64, 66); column 4, lines 59-63] for representing said representation code in humanly interpretable form, said display being connected with said control unit [FIG. 1 (10 and 62)].

Regarding claim 19, Axelrod et al. discloses wherein the at least one mechanical device includes at least one of an inserter device, an insert feeder device [80, 82; 84] and a folding (assembling in Axelrod) device [column 1, lines 42-46; column 5, lines 9-18].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-16, 18, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Axelrod et al. (US Patent 4,800,505).

Regarding claims 9 and 22, Axelrod et al. discloses a system for generating printed mail pieces [FIG. 1; column 1, lines 6-10], starting from a print file [FIG. 1], comprising:

a printer for printing postal items [FIG. 1 (90; 20)];

a processing device [FIG. 1 (10); column 4, lines 5-10] for processing printed postal items [column 2, lines 27-44] into mail pieces, the processing device comprising at least one mechanical device [86] for mechanically acting upon said printed postal items;

a control unit [column 1, lines 42-45; FIG. 1 (10 and 62); column 2, lines 59-65] for controlling unit the printer [FIG. 1 (90; 20)] and the processing device [FIG. 1 (10); column 4, lines 5-10], comprising

an input interface [FIG. 1 (40)] for inputting a rough print file [FIG. 1 (70)] for controlling the printer [FIG. 1 (90)], wherein the rough print file at least partly defines at least one document to be printed [FIG. 1 (70)],

a processor [FIG. 1 (62)] for processing the rough print file [FIG. 1 (70)] in accordance with processing instructions into a processed print file,

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an output interface [FIG. 1 (40)] connected with said printer [FIG. 1 (20)] and with said processing device [FIG. 1 (10); column 4, lines 5-10] for transmitting control signals to at least said printer or said processing device [FIG. 1 (10); column 4, lines 5-10] for controlling said printer and said processing device in accordance with, or formed by, said processed print file, and memory [FIG. 1 (64); column 2, lines 50-52] containing:

a set of processing subroutines with which processing subroutines representation codes for causing said processing instructions to be represented in humanly 'interpretable' form can be composed, which representation codes differ from each other at least as regards processing instructions included therein, are editable by an operator of said system for changing at least said representations of said processing instructions, and are each convertible into a processing code, corresponding with the respective representation code, for controlling said control unit for processing said rough print file into said processed print file, the processed print file comprising instructions for controlling the printer and the processing device [column 3, lines 35-37; column 6, lines 3-4; column 8, lines 39-44 and 48-53; FIG. 3; column 3, lines 58-60; column 4, lines 30-42].

Even though the functional language that is recited in the claims is not word for word taught by the reference, Axelrod et al. discloses a system that is capable of performing the same exact functions. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP 2114. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference

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relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (anticipation rejection affirmed based on Board's factual finding that the reference dispenser (a spout disclosed as useful for purposes such as dispensing oil from an oil can) would be capable of dispensing popcorn in the manner set forth in appellant's claim 1 (a dispensing top for dispensing popcorn in a specified manner)) and cases cited therein. See also MPEP § 2112 - § 2112.02.

Regarding claims 9 and 18, Axelrod et al. discloses the essential elements of the claimed invention, but does not explicitly disclose a set of processing subroutines and set of instructions. Axelrod et al. discloses the flow charts in FIGS. 2 and 3; column 6, lines 9-35, and column 7, lines 41-55; as follows "FIG. 2, shows a flow chart of the operation of computer system (60). To initialize the system an operator first places a known number of inserts to be inserted in items to be mailed by inserter (80) on scale (70) and issues a start up command through operator interface (66), and FIG. 3, shows a flow chart of the above described post-processing subsystem which may be incorporated in existing data processing systems for the generation of control documents with minimal software changes ...", which is obvious to have a set of subroutines and a set of

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instructions in Axelrod et al.'s invention in order to function and process the data. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Axelrod et al. by including set of subroutines and set of instructions, the skilled artisan would have been motivated to modify Axelrod et al. as above for the purpose of manipulating and processing the code in order to perform the required printing.

Axelrod et al., discloses representation code being editable [column 3, lines 12-21] for changing at least said representations of said processing instructions, and said representation code being convertible into said processing code [FIG. 1; FIG. 2; FIG. 3; column 4, lines 53-55]. Axelrod et al. discloses the essential elements of the claimed invention, but does not specifically state that the processing instructions are editable. However, it is inherent that the processing instructions are editable since the code is always editable.

Regarding claim 10, Axelrod et al. discloses wherein said representation code is arranged for editably representing at least variables [column 3, lines 5-21] of said processing instructions.

Regarding claim 11, Axelrod et al. discloses wherein said representation code is arranged for editably representing at least formal parameters [column 3, lines 5-21] of said processing instructions [please see claim 1 for the "instructions"].

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Regarding claim 12, Axelrod et al. discloses a display [FIG. 1 (64, 66); column 4, lines 59-63] for representing said representation code in humanly interpretable form, said display being connected with said control unit [FIG. 1 (10 and 62)]

Regarding claims 5, 6, 13 and 14, Axelrod et al. discloses the essential elements of the claimed invention, but does not disclose a source language and being a script language. Axelrod et al. discloses the flow charts in FIGS. 2 and 3; column 6, lines 9-35, and column 7, lines 41-55; "FIG. 2, as follows "FIG. 2, shows a flow chart of the operation of computer system (60). To initialize the system an operator first places a known number of inserts to be inserted in items to be mailed by inserter (80) on scale (70) and issues a start up command through operator interface (66), and FIG. 3, shows a flow chart of the above described post-processing subsystem which may be incorporated in existing data processing systems for the generation of control documents with minimal software changes ...", which is obvious to have a set of subroutines and a set of instructions in Axelrod et al.'s invention in order to function and process the data. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Axelrod et al. by including set of subroutines and set of instructions, the skilled artisan would have been motivated to modify Axelrod et al. as above for the purpose of manipulating and processing the code in order to perform the required printing.

Regarding claims 7 and 15, Axelrod et al. discloses memory [FIG. 1 (64)] that further contains converter code for converting said source language (please see above for "source

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language”) into a code executable [column 4, lines 53-55] by said control unit [FIG. 1 (10 and 62)].

Regarding claims 8 and 16, Axelrod et al. discloses that the editing code [column 3, lines 14-18] comprises a code generator for generating at least portions of said representation code [column 6, lines 37-68], which code generator is arranged for causing a user interface to be represented [column 6, lines 37-68], with choices from predetermined sets of processing instructions (please see claim 1 for “the instructions”).

Regarding claim 20, Axelrod et al. discloses wherein the at least one mechanical device includes at least one of an inserter device, an insert feeder device [80, 82; 84] and a folding (assembling in Axelrod) device [column 1, lines 42-46; column 5, lines 9-18].

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem H Hamdan whose telephone number is (571) 272-2166. The examiner can normally be reached on M-F (first Friday off) 6:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Andrew H Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wasseem H. Hamdan

August 18, 2004



Daniel J. Colilla
Primary Examiner
Art Unit 2854